

## **REMARKS/ARGUMENTS**

Applicants, for the reasons stated infra, respectfully request reconsideration and allowance of the attached claims. In the alternative, Applicants request the reasons for the rejection of all pending claims be more clearly delineated to allow the proper submission of these rejections to appeal.

Claims 1 and 17 were previously amended to clarify that Applicants' invention transfers multiple records of individual customers from an existing database to the web-based database and does not generally seek to process individual customer data records in an existing database domain, thereby preventing unauthorized modification or corruption of the existing database. The movement of the maintenance of the customer database information also frees the owner of the existing database from the responsibility of address modification and update. If the customer does not wish to have their records maintained, they may simply ignore the request providing them with their specific unique access account code and their information will not be updated. Claim 17 was also amended to clarify that the invention functions with multiple customer data records and further generates unique access accounts for each of the multiple customer data records. In addition, claim 17 was amended to clarify that Applicants' system enables modification of the customer data records.

Claims 24-28 were previously presented to further claim the invention. Independent claim 24 is directed towards a method for customers to update their contact information without registering with the system. Since the customer is accessing his record on the web-based database and not on the internal existing database, no chance for data corruption of the existing database exists. Claim 24 has been further amended to claim the feature of automatic updating based upon additional information provided upon access by the customer. Claim 25 is directed toward specific types of customer information. Claim 26 is directed towards modification of the customer record via a telephone number. Claim 27 is directed towards the modification being a correction.

The attached amendments did not add new matter and were made for clarification of the web-based database creation and maintenance process only. Support for these amendments can be found, *inter alia*, at paragraphs 24, 27, 38 and 42. Applicantss reassert their belief the foregoing amendments place the application in condition for allowance. *Applicants therefore respectfully request further reconsideration and allowance of the existing claims.*

**Refusal to Enter Applicants's Previously Filed Rule 132 Declaration is Erroneous**

Applicants previously filed a declaration under Rule 132 because the Examiner initially found the declaration (without discussing the substance of the

factual statements contained therein) “insufficient” and reiterated her denial of consideration of the declaration because of: a) timeliness, b) not having sufficient explanation why it wasn’t submitted earlier, c) not being detailed as to include order sales invoices, or d) offering an explanation of where or when the sales were made, when and where the systems were first installed, failed to disclose the number of orders fulfilled and other specific accounting detail.

Clearly, the filing of the declaration together with the filing of the Request for Continued Examination makes the filing timely. See MPEP 716.01(A)(4). The declaration was timely for consideration by the Examiner in this RCE proceeding.

The Declaration of Tom Ren, one of the inventors, discloses the dates of first commercial use, a list of customers, the advertising spent on these products and its general acceptance in the trade or business for its intended use. A causal nexus between the claims of the pending application and the success is established in Paragraph 11 of such Declaration and the Examiner wrongfully refused to consider this evidence of the useful and unique features of the invention claimed by Applicants. All of the other criteria used by the Examiner to refuse consideration of the Rule 132 Declaration are unwarranted.

Although Applicantss dispute the Examiner has raised a prima facie case of obviousness in the present Office Action (*In re Rijckaert*, 28 USPQ2d (Fed. Cir.

1993)), the Rule 132 declaration, together with the explanation offered herein, clearly would provide some evidence to rebut any such obviousness rejection.

Moreover, appropos of the Examiner's timeliness argument by way of explanation, Applicants did not believe any Rule 132 would be required after the first Office Interview only because they mistakenly believed—in good faith—the language for allowable claims had been worked out between the Applicants' attorneys and the Examiner.

**Rejections Under 35 USC §103(a) Including A Confusing and Indefinite Reference to "Robertson"**

The rejections in the September 5, 2006, Office Action ("OA") were all obviousness-related based on:

1. U.S. Patent 6182131 to Dean et al. ("*Dean*") in view of U.S. Patent 6175831 to Weinreich ("*Weinreich*") (as to claims 1-4, 6, 7, 9, 11, 12, 17, and 21);
2. *Dean* in view of *Weinreich* and U.S. Patent 6233577 to Ramasubramani et al. ("*Ramasubramani*") and maybe to a patent to *Robertson* (although not identified by serial number as to claim 27 only) (as to claims 24-24, 27-28);

3. *Dean* in view of *Weinreich* and further in view of U.S. Patent 6925477 to Champagne (“*Champagne*”) and maybe to a patent to *Robertson* (although not identified by serial number) (as to claim 5);
4. *Dean* in view of *Weinreich* and further in view of U.S. Patent 6625258 to Ram et al. (“*Ram*”) and maybe to a patent to *Robertson* (although not identified by serial number as to claim 20 only) (as to claims 8, 10, 20, 22 and 23);
5. *Dean* in view of *Weinreich* and *Ramansubramani* and further in view of *Ram* (as to claim 26); and,
6. *Dean* in view of *Weinreich* and further in view of U.S. Patent 6108691 to Lee (“*Lee*”) (as to claim 19).

**Prior Art Reference Cited by Examiner Not Identified by Serial Number**

The Examiner makes a number of references to *Robertson* assumed for the purposes of this response—although not specifically described by the Examiner by serial number out of the 3,681 patents issued to a “Robertson”—to be the same *Robertson* (U.S. Patent 6269369) previously relied upon in prior office actions. These discrepancies were noted in the prior responses to Office Actions, but remain uncorrected. Out of an abundance of caution to properly traverse all of the Examiner’s grounds for rejection--which was the intent of Applicants--Applicants addressed, to the extent understood, the references to *Robertson* in the remarks.

***Applicants respectfully request either removal of the reference to Robertson or a more complete reference to allow proper appellate argument of this rejection.***

### **35 U.S.C. § 103 Rejections**

A prima facie case of obviousness can only be established when the examiner establishes three basic criteria: a) suggestion or motivation in either the references cited or in the knowledge generally available to a person having ordinary skill in the art, to modify the reference or combine the references; b) reasonable expectation of success in so doing; and c) the prior art references must teach or suggest all the claim limitations. *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Merck & Co.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). The burden on the Examiner is described as requiring "...rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999). For the reasons set forth herein, Applicants respectfully will show none of the claimed prior art references relied upon, either alone or in combination, suggest or provide motivation for combining the references in the manner suggested by the Examiner. None of the claimed prior art provides a reasonable expectation of success in achieving the alleged suggested combination, nor do the claimed prior art references teach or suggest all the claim limitations as

described in the amended claims provided above. Picking and choosing features from a number of prior art references does not teach or suggest that such features can or should be combined. *Ex Part Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. and Inter. 1985).

The Examiner misapprehends the standards imposed by the statute and regulations upon the examiner to first review the language of the claim as a whole. MPEP 2141.02. For example, at page 3, the Examiner states: “Clearly, the applied references, *Dean* and *Weinreich* are all concerned to creating user profiles (sic). Thus, these references are analogous and within the same aspects of endeavor and are combinable.” The Examiner then argues, again at page 3 of the Office Action, that it would have been “obvious to a person of an ordinary skill in the art at the time the invention was made to apply *Weinreich’s* teaching of sending a password to a user and using password to logon the system for updating user profile in database 70 to *Dean’s* system in order to notify users to access their new accounts and further allow users directly update their accounts in a web database any time via Internet quickly without take many hours to change their accounts.”

*Dean* is not—in the least—concerned with creating user profiles, but rather in the wholesale transfer of existing user names (and passwords) to a new database domain to allow sign-on by the existing users of the originating database on the new database using the same logon and password. In other words, *Dean* was seeking to

increase the scope of domains for which an existing signon (and password) might work as new domains are added to an existing network. Nothing in *Dean* suggests the motivation to create a duplicate Internet database and provide notification and a new password for the potential users of that new database to sign and update their existing individual contact information. *Dean's* transferred sign-on information is isomorphic in the second database with the information contained in the first originating database. There is no creation of a unique customer number (account access code) performed in the *Dean* reference. Reliance on the "web-based" database of *Weinreich* is also inapposite. Only one database is being accessed in *Weinreich* and links created to database 70 (accessible through the internet) are in no way similar to creating a new database and allowing vendors to access their specific information in this new web-based database using a password blasted to them upon the creation of the second database in accordance with the teachings of the present application. See Fig. 2 of the present application for a description of the topology of the network connections.

The reliance upon an automatic creation of accounts in the second database from information received from the originating database again suggests the Examiner failed to appreciate the appropriate legal standard for an obviousness rejection. Having reduced Applicants' invention to the gist of "creating user profiles", the Examiner completely ignores the problems sought to be solved and the unique and

successful manner of solving these problems offered by Applicants' invention. Furthermore, the Examiner compounded her error by refusing to consider the declaration of commercial success utilizing strained and unwarranted legal standards for which no support can be found. The specific rebuttal to such arguments will be offered infra.

### **Non-analogous Art Does Not Support an Obviousness Rejection**

The combination of *Dean* and *Weinreich* are not in analogous art fields. Class 709, the only class searched in *Dean*, suggests searching in classes 228, 340, 710, 713 and 717, while *Weinreich* provided a search in classes 707, 345, 364, 370, 706, 345, 358, 440, 444, 705, 434 and 364. The differences in the problem sought to be solved by Applicants' invention, not addressed in either *Dean* or *Weinreich*, together with the absence of cross-referencing in the Manual of Classification, suggest that the art is non-analogous and may not be used to find obviousness of the present application. See MPEP 2141.01(a). The Examiner's gratuitous assertion the art areas are analogous maybe be gratuitously denied. As noted at p. 3 of the Office Action, "[t]hese references are analogous and within the same aspects of endeavor and are combinable" improperly states the legal test and provides Applicants little or no information to properly traverse the rejection or frame a response. ***Applicants respectfully request the Examiner withdraw the rejection on this ground or more clearly delineate the facts behind the statement the references are analogous.***

**Summary of Prior Art Relied Upon for the 35 U.S.C. § 103(a) Rejections**

None of the prior art relied upon by the Examiner addresses the problem sought to be solved by Applicantss. None of the prior art cited suggests or offers any motivation to combine the references cited by the Examiner and the Examiner does not rely upon knowledge generally available, to modify the reference or to combine reference teachings. *Dean*, the primary reference relied upon, is a patent for automatically populating a second network or domain by polling an existing network or domain for a plurality of existing user names, which are then passed to a second network account manager program which creates an account in the second network for each of the plurality of user names exactly as they are shown in the originating database.

This automatic population saves the original plurality of users from the need to individually sign into the second network to set up their own user name on the second network. Col. 1, lines 36-43. The automatic population feature is intended to save each user from having to sign onto a new database and establish an account using their sign-on and password. The system did not intend to create or teach creating a unique new account access code and password and forwarding that password to parties outside of the organization so that they could sign-on to the web-based database to correct information relied upon by the creating entity to contact them of the present claimed invention. Rather, *Dean's* signon (and

password, if passed) will be the same in both the originating database and the new database. If *Dean* created a unique signon, known only to the outside customer, the whole purpose of *Dean*'s automatic creation of identical accounts in a second database domain would have been frustrated.

*Weinreich* is a patent for creating, updating and maintaining a single networked database wherein each user of the database may create relationship fields to allow linking to other users having similar relationship fields in their respective records. This permits searching or organizing the database by relationships rather than individual account identifiers. See generally Cols. 3 and 4. Each user must become (ie. register) by their separate registrations in the database to become a "member." See the description of the BAM routine of the DSP 12. Col. 7, lines 4-23. Each "user" is pre-registered in the system before the linking takes place. *Weinreich* does not broadcast a password signon to individuals outside of those who initialized their own account within the system.

*Ramansubramani* provides a database of user certificates for timely and efficient association with, and an updating of, a user device thereby allowing secure communication between the user device (such as cell phone) through the secure network. This system permits the use of digital certificates and distribution of those certificates from a database to thin clients (having little or no memory or computing power). This feature allows management of an existing secure

connection without unnecessary restriction on the user device. There is absolutely no similarity between the claimed invention of the present application and the invention disclosed in *Ramansubramani*. The Examiner uses the self-provisioning description to argue that *Ramansubramani* discloses accessing the central database to download the name and password to the thin-client (ie. cell phone). Clearly, some greater explanation of the pertinence of *Ramansubramani* should be required before this reference is used to suggest obviousness.

*Champagne* is a patent for a system which automatically populates a second database from records in first database irrespective of the correspondence between the fields of each database using a field mapping process which directs a data transfer protocol to establish the link between the first and the second databases.

*Ram* is a patent for a communication management system which coordinates telephone and data services through a virtual [communications] assistant system, VAS, which allows subscriber access to phone messages from e-mail access portals, listening or sending e-mails from a telephone, forwarding of e-mails to a fax machine, through a single number access for each subscriber/user. Col. 3, lines 33-51.

United States Patent No. 6,269, 369 to *Robertson*, if this is the reference intended by the Examiner, is a patent for coordinating a personal contact manager database on a client with a single relational database on a networked server,

thereby allowing the individual to allow access on an individual basis to certain data concerning the granting user to the browsing user. See Abstract.

The Examiner engaged in inappropriate “picking and choosing” of separate features from each of these patents to argue that the Applicants’ invention would have been obvious to one having ordinary skill in the art, without the slightest hint of analyzing how the separate prior art patents suggested or taught the combination. For example, as noted above, the Examiner cites *Ramansubramani* solely for the proposition that it allows a user to change his username and password. Office Action, p. 25. The Examiner concludes this section “It would have been obvious...to apply Weinreich’s teaching of sending a password to a user and using password to logon the system for updating user profile in database 70 and Rama teaches a user may change his username and password to Dean’s system in order to notify users to access their new accounts and further allow users directly update their accounts in a web database anytime via a network system quickly without take many hours to change their accounts and prevent other users access a personal account of a user without permission.” Significantly, and fatally to the position taken by the Examiner, there is no suggestion in any of the references relied upon for this summary argument for combining the references in the manner not claimed to be “obvious.”

The fact that references can be combined or modified is insufficient to establish a prima facie obviousness rejection. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is insufficient by itself to establish prima facie obviousness. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). The proposed modification of *Dean*, the primary reference, to create unique account numbers would render *Dean* unsatisfactory for its intended purpose because the originating user would not be able to sign into the newly opened database domain. The proposed modification of *Weinreich* to allow user signons and modifications of the “web-based” database 70 is contrary to the Applicants’s plan to establish a second web-based database 32, Fig. 2, which prevents unauthorized or inappropriate modification of the vendor records on the existing database 10. *Weinreich* is inapplicable to the present invention. *Ramansubramani* relates to the ability of a thin-client to access the authorized certificate database, using a previously established digital key, and modify the user name and password identified with that digital key. The significant data containing the digital certificate and the encryption key has already been passed to the thin-client. The teaching of *Ramansubramani* cannot be combined with *Dean* and *Weinreich* to make any feature of Applicants’ invention obvious.

A further detailed analysis of the Examiner's erroneous analysis demonstrates the compounding of these errors in the Examiner's rejection of all claims pending.

**Dean in view of Weinreich to reject claims 1-4, 6, 7, 9, 11-12, 17, 21**

Claim 1 is rejected under 35 USC §103 because of *Dean* in view of *Weinreich*. The Examiner argues that *Dean* teaches automatic creation of user accounts in an external network so that users may access that external network, ie. users within the owner's network are automatically signed into the remote network. This is not the same as customer records being used to create a database in a web-based database to allow the customer to update the individual customer records within that database for later selective access by the owner of the originating existing database. The *Dean* disclosure does not foresee the customer accessing its record and correcting the information contained in the database. Most importantly, *Dean* assumes the timeliness and integrity of the information transmitted to the newly opened network database domain. Applicants assume the information is stale, unreliable and in need of correction. Applicants' invention intends for the individual customer to access and correct any outdated, incorrect or misinformation contained within the web-based database. As the Examiner cogently admits "[t]he account manager of the ISP is not maintained and updated. The account manager of the ISP is a storage and not a web-based database." Office

Action, p. 4. Applicants' and *Dean's* system are significantly different and teach away from each other.

The account registry, which is copied in *Dean*, is part and parcel of the operating system and creates a gateway into the initiating database for a browsing party. To allow a stranger, to have access to this information would completely compromise the original database system as well as the operating system upon which it resides. Clearly, *Dean* cannot be readily combined with any of the other cited prior art references to support an obviousness rejection, and no system manager would allow such a wholesale access to his operating system records.

Claim 17, the second independent claim the Examiner deems obvious because of *Dean* in view of *Weinreich* is likewise rejected because the Examiner picked and chose elements from prior art which was claimed to be the same as that disclosed and claimed. The Auto-Populator feature of the claimed invention clearly takes database information and establishes a new web-based database with fields populated from the owner's database. This new web-based database then assigns new account identification to the customer accounts transferred and automatically broadcasts a message to the customer with a sign-on and password wholly different than those of the originating database to allow the customer to sign on and update its records on the system. This is entirely different than the topology of the *Dean* disclosure where the original users are being automatically

signed into a newly opened database system so that the multiple users in the first database would not be required to sign onto the system and create a new account one by one. No outsider will ever be allowed to access the newly created database of *Dean* since it is only to be accessed by the existing identified users. As previously noted, *Dean's* account registry 30 from the LAN 10 is part of the operating system of the originating database and is generally only accessible to operating system personnel having sufficient privileges to allow access to this sensitive information. See *Dean*, Col. 2, line 65-Col. 3, line 7. As such, it contains the vital information necessary to give priority and privileges to requests made by the user. This information is not generally made available beyond the confines of the original operating system registry. This information is never made available to other users. *Dean* is not analogous to the creation and use of a second database for contacting customers.

Applicants' web-based database claimed in claim 17 is wholly unlike *Dean's* newly-opened database domain and cannot be combined with the single database system of *Weinreich* to make claim 17 obvious. The ability to sign onto the *Weinreich* database (for those who have previously become members and obtained their own passwords through the BAM routine previously discussed, and who have previously sought to create relationship fields within their own record to link with other users, is certainly not analogous to allowing a single user accessing

their account to correct customer information errors while at the same time permitting rapid communication to all database-listed customers. The Examiner jumped from using a password to sign into the system to the conclusion that Weinreich taught the creation and sending of a password to a user new to the system. Accordingly, the Examiner again wholly failed to establish a prima facie obviousness rejection by use of the *Dean* and *Weinreich* prior art references.

Similarly, Applicantss' third independent claim 24 describes a method of automatically populating, maintaining and updating a web-based database created from customer records obtained from an existing database. Applicants' comments relating to claims 1 and 17 are incorporated herein by reference. As previously noted, although the Examiner concedes the account manager of the ISP is "a storage and not is a web-based database...." (Office Action at page 13), Applicantss specifically claim a web-based database. No indication exists that *Dean* creates new unique temporary access accounts for each of the multiple customers, nor checks those temporary access accounts for duplications and validity, nor broadcasts those temporary access accounts to the customer, previously unregistered, with instructions to use the temporary account to sign into the web-based database to update their own records, thus relieving the originating operating system from the burden and security issues of having third parties access an internal database (the "originating database" of the disclosure).

**Dean in view of Weinreich and Ramansubramani to reject claims 24-25 and 27-28**

In the latest Office Action, the Examiner has found a new reference to *Ramansubramani* to combine with *Dean* as primary reference and *Weinreich* to reject claims 24, 25, 27 and 28. As previously noted, by picking and choosing elements of each cited prior art reference (and irrespective whether they suggest they could be reasonably combined) the Examiner rejects claims 24 based on *Dean* and *Weinreich* and adds *Ramansubramani* to discuss a user changing his username and password (but for not other apparent purpose). Claim 25 was rejected based upon *Dean*'s contact information being combined with e-mail contact information found in *Weinreich* to suggest it would have been obvious to combine the two. Although there is no indication of the compatibility of the two systems described with each other.

The Examiner next injects (inexplicably) *Robertson* in a confused discussion of claim 27 and claim 24 to note that *Robertson* teaches making a correction and therefore making a correction as suggested in Applicants's claim 27 is obvious. There is no explanation of the manner in which the new database of *Dean* or the central (web-accessible) database of *Weinreich* could be accessed with *Robertson* to permit the correction suggested in Claim 27.

The Examiner retreats as to claim 28 to using *Dean* and *Weinreich* as prior art references to find the claim obvious. Thus apparently only claim 24 is rejected over the combined references of *Dean*, *Weinreich*, and *Ramansubramani*. The Examiner has wholly failed to show how these prior art references suggest or teach the combination claimed to have been made obvious, and Applicants respectfully request the Examiner more fully explain the teachings of each to support the motivation to combine these disparate references.

**Dean in view of Weinreich and further in view of Champagne to reject claim 5**

Although claim 5 is dependent from claim 1, the Examiner further cites *Champagne* as making claim 5 obvious because automatic mapping was done prior to Applicants' filing. As acknowledged in Applicants' disclosure, "mapping of database fields is well known in the art, and one of ordinary skill in the art will recognize the numerous ways of accomplishing such mapping." Para. 24. The Examiner's reliance upon *Champagne* in combination with *Dean* and *Weinreich* is again picking and choosing features and refusing to recognize the claimed invention "as a whole." It is not automatic mapping that's patentable, but rather the entirety of Applicants' claimed invention that's unobvious and therefore patentable. No explanation of the prior art is offered in the context of the invention claimed as a whole and therefore the Examiner has wholly failed to discharge the burden of establishing a prima facie obviousness rejection.

**Dean in view of Weinreich and further in view of Ram (and perhaps Robertson) to reject claims 8, 10, 20, 22, 23 and 26**

*Ram* (and perhaps *Robertson*) are combined with *Dean* in view of *Weinreich* to support the Examiner's rejection of claims 8, 10, 20, 22, 23 and 26. While it is not entirely clear how each of the cited references are combined because the Examiner wholly fails to specify the teaching in each which leads to the conclusion they are combinable, it appears that the function of telephone, pager, or fax communication is the intended manner of communication sought to be made obvious. The combination of these forms of communication with the disclosures of *Dean* and *Weinreich* is really not explained by the Examiner. Again, the communication feature is picked from the cited prior art reference and offered as proof of the obviousness of the claimed combination claimed in Applicant's disclosure. No explanation of how the references teach or suggest the combination is offered and thus the Examiner has failed to carry her burden of establishing a prima facie obviousness claim in the present case. *Robertson* does not suggest or teach allowing browsing by telephone or fax, nor does it teach notification by automatically generated telephone or fax communication to the proposed browsing party. Consequently, the Examiner has failed to establish even a prima facie case of obviousness with the cited prior art references.

**Dean in view of Weinreich and further in view of Lee to reject claim 19**

The examiner picks and chooses *Lee* in combination with *Dean* and *Weinreich* to attempt an obviousness rejection of claim 19. *Lee* teaches providing a method of receiving e-mail messages without disclosing the e-mail address of the recipient so the user will not be bothered with excessive junk e-mail blasts. The Examiner uses *Lee* to support an obviousness rejection by supposing Applicants' invention related to the sending of multiple database records to different vendors. While, again, it is not entirely clear how this cited prior art relates to the rejected claim 19, Applicants assert the Examiner was again engaging in impermissible picking and choosing of features to establish obviousness without consideration of the claimed invention as a whole.

**Dependent Claims Should be Allowed if the Independent Claim is Allowed**

Claims 2-4, 6, 7, 9, 11, 12 all depend from claim 1 and would be allowable if claim 1 is allowable. Claims 19-24 all depend from claim 17 and would be allowable if claim 17 is allowable. Claims 25-28 all depend from claim 24 and would be allowable if claim 24 is allowable. See MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**The Obviousness Argument Raised By The Examiner Does Not Support the Rejection of Applicants's Invention as Claimed**

The prior art must suggest the desirability of the claimed invention. It did not. The mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. No showing was made that the references themselves suggested the combination claimed by Applicants. Moreover, the mere fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. The Examiner did not claim that the invention was obvious because it was within the skill of the ordinary artisan to make the claimed combination. The proposed modifications required by each prior art reference cited by the Examiner rendered the prior art unsatisfactory for its intended purpose and therefore cannot be combined to uphold a finding of obviousness as to Applicants' claimed invention. The proposed modifications required would change the principle of operation of each reference cited and therefore render them inapplicable to an obviousness rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must

be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner's analysis of the prior art in the Office Action of September 5, 2006 fails in all three aspects of this well-delineated test. ***Applicants therefore respectfully request the Examiner withdraw her rejection of the claims, or in the alternatively, more clearly describe the teachings of each of the prior art patents relied upon to suggest the combination claimed by Applicants or to make the combination obvious.***

### **Conclusion**

During the course of these remarks, Applicants have at times referred to particular limitations of the claims that are not shown in the applied prior art. This shorthand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction. Unless Applicants have specifically stated that an amendment was previously made to

distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention.

If the Examiner has any questions or comments regarding this communication, she is invited to contact the undersigned directly to expedite the resolution of this application. Applicants respectfully request the Examiner either withdraw her prior rejection, after consideration of the legal standards and argument contained herein, or alternatively to more clearly delineate the reasons for finding each of the prior art references combinable to make Applicants' invention obvious.

Respectfully submitted,

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